

Remarks

This Amendment responds to the Office Action mailed April 1, 2009. With this amendment, Applicants amend claims 1, 2, 4, 5 and 8-11, and add claims 12-14.

Support for the amendment can be found throughout the application as filed, including, for example, pages 9-10, paragraphs [0021] and [0022] of Applicants' specification. No new matter is added.

Information Disclosure Statement

Applicants thank the Examiner for acknowledging receipt of the Information Disclosure Statement filed on May 29, 2008, and for returning electronically signed copy of the Form PTO-1449 submitted therein.

Applicants note that the Form PTO-1449 is not completely initialed as the Other Documents section is not initialed. Accordingly, Applicants are forwarding another copy of the Form PTO-1449 and request that the Examiner forward a completely initialed copy of the form with the next communication from the Patent and Trademark Office.

Foreign Priority

Applicants express appreciation for the acknowledgment of the claim of foreign priority as well as receipt of the certified copy of the priority application. Applicants note that, in contrast to the indication in the Office Action, an English translation of the priority application is not necessary unless a reference is being antedated.

Response to Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1 and 4 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Nagano et al. (JP 2000239272, hereinafter “Nagano”). The rejection asserts that Nagano teaches a compound of formula (I) comprising a ring structure on the phenyl moiety capable of trapping a zinc ion.

In response, to advance prosecution of the application and without expressing agreement or acquiescence to the propriety of the rejection, claims 1 and 4 have been amended. Applicants submit that Nagano does not disclose each and every feature recited in the pending claims whereby the rejection is without appropriate basis and should be withdrawn.

Accordingly, Applicants respectfully request that the 35 U.S.C. § 102(b) rejection be withdrawn.

Response to Claim Rejections Under 35 U.S.C. § 102(e)

Claims 1, 3, 6, and 7 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Lam et al. (U.S. Provisional Application No. 60/469,031). The rejection asserts that Lam teaches a phenyl xanthene dyes that have an overlapping genus with the claimed compound.

Initially, Applicants note that the rejection is improper as the rejection is based upon a provisional application. Accordingly, the rejection should be withdrawn at least for the reason that the provisional application is not appropriate prior art under 35 U.S.C. 102.

Therefore, if any rejection is based upon the disclosure of Lam an appropriate basis for setting forth the rejection should be made, and the rejection should not be made final.

Moreover, in order that the record is complete, Applicants note that PAIR shows at least U.S. Patent No. 7,491,830 and US 2009/0172899 A1 claiming priority to U.S. Provisional Application No. 60/469,031.

While Lam is not appropriate prior art, to advance prosecution of the application and without expressing agreement or acquiescence to the propriety of the rejection, claim1 has been amended. Moreover, Applicants submit that the subject matter recited in claim 6 is not sufficiently envisaged in Lam so as to constitute anticipatory prior art. In this regard, the rejection merely asserts an overlapping genus, but does not in any manner point out wherein Applicants' claimed subject matter is disclosed in Lam so as to constitute anticipation.

Applicants submit that Lam does not disclose each and every feature recited in the pending claims whereby the rejection is without appropriate basis, and should be withdrawn.

Accordingly, Applicants respectfully request that the 35 U.S.C. § 102(e) rejection be withdrawn.

Response to Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1 and 2 are rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the enablement requirement. The rejection contends that while the specification enables the preparation of the claimed formula (I), it does not reasonably provide enablement for determining the claimed electronic properties of the benzene ring, such as the electron density or oxidation potential of the benzene ring before and after trapping a proton, a metal ion, or an active oxygen species. The rejection asserts that while these properties can be assessed for the compound claimed, it is unclear how these determinations are made for the functional group itself.

In response, Applicants note that determining the oxidation state and electron density of a compound and its substituents, including that of a benzene ring, are known techniques, and Applicants have provided sufficient guidance for one having ordinary skill in the art to practice the claimed subject matter without undue experimentation. For example, Applicants direct the Examiner's attention to Applicants' specification, at pages 11 and 12, paragraph [0028] which provides standard techniques that can be used to determine the electronic properties. For example, the specification provides that the electron density of the benzene ring can be obtained by calculating the oxidation potential of the benzene ring using a quantum chemical technique. Furthermore, the specification discloses that the oxidation potentials described are values obtained by using a saturated calomel electrode (SCE) as a reference electrode.

Moreover, the paragraphs following paragraph [0028] and the remainder of Applicants' disclosure provide even further guidance to practice Applicants' claimed subject matter without undue experimentation.

Therefore, Applicants submit that the specification enables one having ordinary skill in the art to practice the claimed subject matter, including how to determine the claimed electronic properties of the benzene ring, such as the electron density and oxidation potential of the benzene ring before and after trapping a proton, a metal ion, or an active oxygen species.

Accordingly, Applicants respectfully request that the 35 U.S.C. § 112, first paragraph rejection be withdrawn.

Response To Claim Objections

Claims 5 and 8-11 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

In response, claims 5 and 8-11 have been amended. Claims 5, 8, and 9 have been amended to be in independent form substantially including the recitations of their parent claims, and claims 10-11 have been amended to depend upon claim 5.

Accordingly, this ground of rejection should be withdrawn, and claims 5 and 8-11 should be allowed.

In view of the foregoing, Applicants respectfully request withdrawal of the rejections and objections of record. Furthermore, Applicants submit that at least for the reasons set forth above, newly-added claims 12-14 are allowable.

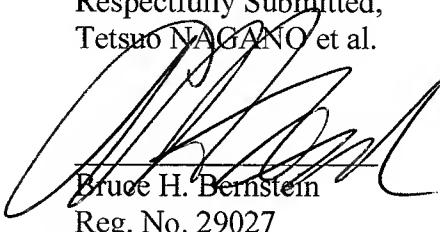
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow each of the pending claims.

Applicants therefore respectfully request that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Should the Examiner have any questions regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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